

### Remarks

The specification, drawings, and claims 8, 26, 30 and 33 have been amended. Claims 23-25, 35, 43, 44 and 54-57 have been canceled. Review and reconsideration in view of the amendments and remarks below are respectfully requested.

The status indicator of claim 3 has been corrected as requested in the Office action. The specification and drawings have been amended to address the objections thereto.

Claims 8 and 30 have been amended to address the 35 U.S.C. §112 rejections thereto. In particular, those claims have been amended to clarify that the inner surface is located outside the outer surface when the pouch is in its external position/inverted configuration (shown in Figs. 5 and 6).

Claim 23 has been amended to address the 35 U.S.C. §112 rejection thereto.

### Claim 1

Claim 1 is rejected as being anticipated by U.S. Pat. No. 2,292,347 to Bailey. However, the Office action has taken an improper interpretation of the Bailey reference in formulating its rejection. In particular, the Office action, at the second line of page 5, refers to Fig. 1 of the Bailey reference. In Fig. 1, the "pouch" of Bailey is in a flat configuration in the form of a sheet 11 coupled to the garment along stitching line 12 and includes a pair of zipper tracks 16, 17 on opposite edges thereof. The upper mouth is indicated to be shown by reference number 15 of Bailey, and the lower mouth is indicated to be shown by reference number 14 (page 5, line 1). When Fig. 1 of Bailey is compared to claim 1, several elements/features of claim 1 are not shown; for example, at least: 1) a pouch; 2) a pouch defining a generally closed shape having an inner volume; 3) the pouch being shaped and sized to receive generally all of the outer shell in the inner volume; 4) the pouch including an upper mouth and a lower mouth; and 5) selectively openable and closable upper and lower mouths.

At page 5, lines 4 and 5, the Office action indicates that *when* the upper and lower mouths are closed, an inner volume is inherent and *would* form a closed loop shape. In this case, when the "when"s and "would"s are implemented, the pouch of Fig. 3 of Bailey would result. However, the pouch of Fig. 3 lacks at least the following claimed features of claim 1: an upper mouth and a lower mouth located on generally opposite sides of the pouch, wherein the upper

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mouth and the lower mouth are both selectively openable and closable. Instead, what has been construed as the "mouths" of Bailey (edges 14 and 15) are positioned adjacent to each other and are not on generally opposite sides of the pouch.

If the Office action takes the position that the claimed mouths can be found at the axial ends of the pouch in Fig. 3 of Bailey (which is not specified in the Office action), then it can be seen that those mouths are not selectively openable and closeable, and further lack the fastening mechanisms of claims 3 and 5 (which are indicated to be anticipated by Bailey).

Thus neither Fig. 1, nor Fig. 3, of the Bailey reference by itself discloses the subject matter of claim 1. The Office action appears to take the position that Fig. 1 of Bailey discloses some features of claim 1, and that Fig. 3 discloses various others feature. However, Figs. 1 and 3 of Bailey represent *different states* of that garment. Thus Fig. 1 and Fig. 3 of Bailer are mutually exclusive and *cannot exist at the same time*.

As indicated in MPEP 2131, in order to show anticipation: "The identical invention must be shown in complete detail as is contained in the claim." Neither Fig. 1 nor Fig. 3 of Bailey anticipates claim 1. The Office action seems to attempt to create some sort of a hybrid structure of Figs. 1 and 3 of Bailey; but such a hybrid structure is physically impossible. A single structure; that is, a structure that is identical to that of claim 1, is required for anticipation, and that structure is simply not shown in Bailey. As noted in *Ex parte Beuther*, 2006 WL 1665666, (Bd. Pat. App & Interferences 2003) "It is well settled that anticipation is not established if in reading a claim on something disclosed in a reference it is necessary to pick, choose, and combine various portions of the disclosure not directly related to each other by the teachings of the reference." *See also Akzo N.V, v. U.S. International Trade Commission*, 808 F. 2d 1471, 1480 (Fed. Cir. 1986). Thus it is submitted that the rejection of claim 1 is improper and should be withdrawn.

#### Claim 49

Claims 49, 60 and 61 are rejected as being anticipated by U.S. Pat. No. 4,476,587. However, the Itoi reference clearly entirely lacks an entire claim limitation of claim 49. In particular, claim 49 specifies that the outer shell can resist igniting, burning, melting, dripping or separation at a temperature of 500°F for at least five minutes. At paragraph

9, the Office action takes the position that any and all fabric or material of a jacket would provide some degree of protection against abrasion, flame and heat. While this may be true, claim 49 does not specify that the outer shell must provide "some degree of protection." Instead, that claim provides a definite, clear, and meaningful description of the properties of the outer shell, with numerical precision.

The Office action indicates that the Office does not have a laboratory to perform testing and cannot therefore ascertain the level of protection that Itoi would provide. While this point is understood and appreciated, this does not effect the fact that in order to anticipate a claim, the reference must teach every element of the claim ("A claim is anticipated only if each and every element as set for in the claim is found, either expressly or inherently described, in a single prior art reference [citations omitted]" MPEP §2131). If a claim limitation cannot be found in document, than that document is simply not an anticipatory reference.

At paragraph 26 of the final Office action, the Office action takes the position that the limitation directed to resistance of igniting, burning, melting or dripping is a functional recitation. However, even if were true, a functional limitation must be considered and given patentable weight. As noted at MPEP §2173.05(g), "A functional limitation must be evaluated and considered, just like any other limitation, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." Thus the limitation at issue must be considered and identified in an allegedly anticipatory reference.

In any case, it is submitted that limitation at issue is not a functional limitation. The limitation directed to resistance of igniting, burning, melting or dripping defines a material property of the garment, much like a garment that is specified to be water-proof. A garment either has this property, or it does not, and the property does not describe some activity carried out by the garment.

MPEP §2114 inherently describes a functional limitation as a "recitation with respect to the manner in which a claimed apparatus is intended to be employed," citing *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). For example, the limitation of "an assembly for transversely shearing a sheet of material" would appear to be a functional limitation. A limitation directed to resistance of igniting, burning, melting or dripping does not recite a manner

in which the garment is intended to be employed; rather, it described a clear, definite and specific garment quality.

In addition, As noted at page 5, lines 9-20 of this application, National Fire Protection Association ("N.F.P.A.") standards specify various minimum requirements for protective firefighting garments, including having an outer shell that can resist igniting, burning, melting, dripping and/or separation at 500°F for five minutes. Thus these properties are desired to protect the wearer and to ensure the garment meets N.F.P.A. standards. Thus the claim limitation relating to the resistance of igniting, burning, melting, dripping or separation is a carefully selected and meaningful limitation, and is utilized by the N.F.P.A. for its certification standards. Thus the limitation is clearly structural and not functional as it is a basic safety standard used by a national standards-setting organization.

Finally, on the last two pages of page 6 of the Office action, it is indicated that because the specific types of fabric are not claimed, the cited reference meets the claim limitations. The Office action does not cite any support for its proposition, and indeed, it is submitted that this is not a proper statement of claim constructions. Under MPEP §2116.01, "All the limitations of a claim must be considered when weighing the differences between the claimed invention and the prior art...." (emphasis in original). As indicated above, MPEP §2173.05(g) specifies that a functional limitation must be evaluated and considered. The Office cannot unilaterally ignore meaningful claim limitations to find anticipation of a claim. Thus it is respectfully submitted that the rejection of claim 49 should be withdrawn.

#### Claim 26

Claim 26 has been amended to include the subject matter of claim 35, and claim 35 has been canceled. Accordingly, claim 26 now specifies that each mouth is a generally closed loop shape, and that the pouch is fixedly coupled to the outer shell generally around the perimeter of the upper mouth. For example, as shown in Fig. 4 of this application, the pouch 50 is attached to the outer shell 30 along its upper edges 60.

In contrast, the only place in which the sheet 11 of Bailey is attached to the body of the garment of the Bailey reference is along stitching line 12. The upper edge 15 of the sheet 11, which has been construed as the "upper mouth," is not fixedly coupled to the outer shell along

any of its "perimeter." Moreover, the "pouch" shown in Fig. 3 of Bailey is not directly attached to the outer shell generally around the perimeter thereof. The subject matter of amended claim 26 is simply not shown in the references cited against that claim.

At paragraph 22 of the Office action, it is indicated that "When interpreted in the broadest reasonable sense, the stitching 15 of Bailey is generally around the entire perimeter of the mouth." It is assumed that the Office action intended to refer to the stitching 18 of Bailey which is positioned adjacent to the top edge 15. However, the stitching 18 attaches a zipper 17 to the sheet of material 11 (column 3, line 55 – column 3, line 4). Stitching 18 does *not* attach the sheet 11 to the outer shell; instead, that is the function of stitching 12 (column 2, lines 50-54). It can be seen that stitching 12 does not directly attach the pouch to the outer shell generally around the perimeter of the upper mouth in any reasonable sense. The stitching 18 (and upper edge 15) simply do not fixedly couple the pouch to the outer shell generally around the perimeter of the upper mouth.

Fixedly coupling the pouch to the outer shell around the perimeter of the upper mouth helps to properly position the pouch, and allows quick easy and predictable access to the mouth. Since the references cited against claim 26 (and claim 35) do not show the subject matter of amended claim 26 it is submitted that claim 26 distinguishes over the cited references.

Accordingly, it is submitted that the application is now in condition for allowance and a formal notice thereof is respectfully solicited.

It is noted that the first Office action includes copies of the references submitted by the Applicant in various Information Disclosure Statements. The foreign references, namely, FR 2,594,009, GB 2,333,949 and JP 1,0192,028 have been initialed by the Examiner, but were also struck-through. The undersigned spoke with the Examiner via telephone on October 17, 2006, and the Examiner indicated that these references have in fact been received and considered by the Examiner, and they should not have been struck-through. The undersigned noted this conversation in the Amendment mailed on November 28, 2006, and requested confirmation that these references have in fact been considered. However, the most recent Office action does not include any confirmation or discussion of this issue. **Accordingly, it is again requested that the Office provide confirmation that these foreign references have been considered, or notify Applicant if further action is required to confirm consideration of these references.**

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The Commissioner is hereby authorized to charge any additional fees which may be required by this paper, or to credit any overpayment to Deposit Account 20-0809. Applicant hereby authorizes the Commissioner under 37 C.F.R. §1.136(a)(3) to treat any paper that is filed in this application which requires an extension of time as incorporating a request for such an extension.

Respectfully submitted,

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